



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/434,965	11/05/99	LUXEMBURG	A ORT-1060

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HM12/0314

EXAMINER

DIBRINO, M

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 03/14/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/434,965

Applicant(s)

Luxemburg et al.

Examiner

Marianne DiBrino

Group Art Unit

1644



☒ Responsive to communication(s) filed on Nov 5, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 16-18 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 16-18 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3 Filed 8/21/00

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

### DETAILED ACTION

1. Applicant's amendment filed 11/5/99 is acknowledged and has been entered.

Claims 16-18 are pending.

2. It is noted that this application appears to claim subject matter disclosed in prior copending Application No. 60/025,588. A reference to the prior application must be inserted as the first sentence of the specification of this application if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e). See 37 CFR 1.78(a). Also, the current status of all nonprovisional parent applications referenced should be included.

The first sentence of the specification should refer to the provisional application using language such as:

This application claims the benefit of U.S. Provisional Application No. 60/\_\_\_\_, filed \_\_\_\_.

See MPEP 1302.04

If a statutory reference is included in this statement, it must be to 35 USC 119(e) and not to 35 USC 120.

In addition, it is noted that Applicant has not pointed out the relationship of the parent application 08/909,549 to the instant application, i.e., Applicant did not check a box on the said amendment filed 11/5/99 at item #16.

Applicant should amend the first line of the specification to update the status and relationship of the priority documents.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 16-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is indefinite in the recitation of "bead" because it is not clear what is encompassed by the recitation of "bead". The word "bead" is not defined in the instant specification. OK

Claim 16 is indefinite in the recitation of "matrix" because it is not clear what is encompassed by this term. The instant specification discloses that a wide variety of MHC coated substrates are suitable for use in the present invention (especially page 6 at lines 4-9). OK

It is indefinite and ambiguous to recite "peptide" in claim 16 after "Class I" because it is the Class I complex that is "empty" and capable of binding to peptide antigens. OK

5. The invention is drawn to a matrix for capturing antigens comprising a support having on its surface immobilized empty Class I peptide, wherein the Class I peptide is capable of binding one or more antigens. With regard to application of prior art, the instant application, with is only entitled to priority of the immediate parent application 08/909,549, because the scope of the claimed invention is not disclosed in provisional application 60/025,558. The parent application 60/025,558 is drawn to a magnetic bead having on its surface immobilized empty Class I molecules preloaded with antigen.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371<sup>©</sup> of this title before the invention thereof by the applicant for patent.

7. Claims 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated U.S. Patent No. 5,731,160.

Patent No. 5,731,160 discloses antigen presenting lipid bilayer carrying vehicles (i.e., matrices), including liposomes, incorporating empty MHC molecules that are capable of binding peptide antigens (especially column 5 at lines 53-59). Claim terms are interpreted not only in light of the specification but also in light of the prior art. See In re Cortright, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999). Claim 17 is included because when claim 17 is given its broadest reasonable interpretation the limitation "bead" can include "liposome".

The reference teachings anticipate the claimed invention.

8. No claim is allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne DiBrino whose telephone number is (703) 308-0061. The examiner can normally be reached Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

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Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

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March 8, 2001

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